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09/801,593	03/08/2001	Rick Allen Hamilton II	AUS920010026US1	4863

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EXAMINER

BASEHOAR, ADAM L

ART UNIT PAPER NUMBER

2178

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/801,593

**Applicant(s)**

HAMILTON ET AL.

**Examiner**

Adam L Basehoar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications: The Amendment filed 09/01/04 to the original Application and IDS filed on 03/08/01.

2. The objection to claims 3 and 10 have been withdrawn as necessitated by Amendment.

3. Claims 7, 14, and 21 have been cancelled as necessitated by Amendment.

4. The rejections of claims 1-6, 8-13, and 15-20 have been withdrawn as necessitated by Amendment.

5. Claims 1-6, 8-13, and 15-20 are pending in this case. Claims 1, 8, and 15 are independent claims.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 8, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding claims 1, 8, and 15, the phrase "any present web browser extensions" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "any"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3, 6, 8-10, 13, 15-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen et al (US-6,055,542 04/25/00) in view of Smith, JR. et al (US-2002/0128898 09/12/02).

-In regard to independent claims 1, 8, and 15, Nielsen teaches a method, system, and computer medium for creating a list of interest terms for a user of a web browser system comprising (Abstract):

providing a user dialog on said user display (column 4, lines 20-40), said user dialog comprising a sequential prompting for input (column 4, lines 29-37);

receiving at least one user interest selection of a general category (column 4, line 37)(Fig. 3: 58);

creating a user interest term list containing selected interest terms(column 4, line 38)(Fig. 3: 60);

disposing said interest term list on said web browser system (column 4, lines 39-40)(Fig. 3: 62); and

allowing said web browser and present web browser functional extensions to access said disposed interest terms (columns 4-5, lines 45-67 & 1-17).

Nielsen does not teach wherein when the user was queried as to interest in general categorical terms with suppression of sub-category and specific terms unless the user's response was affirmative, followed by further sequential prompting as to user interest in sub-categories and specific terms limited to terms associated with the affirmatively-answered general categorical terms of interest. Smith teaches a user interest selectable interface (Page 12: Paragraph 0176: "a set of cascading screening questions are presented") wherein a user was queried by general categorical terms (Page 12: Paragraph 0176: "asking whether they are "male" or "female"?") with suppression of sub-category and specific terms (Page 12: Paragraph 0176: "present one or more...directed to females" or "present one or more...directed to males") unless the user's response was affirmative (i.e. selects either male or female in this example), followed by sequential prompting (cascading prompting) as to user interest in sub-categories and specific terms associated with the affirmed general category (Page 12: Paragraph 0176: "present one or more...directed to females" or "present one or more...directed to males"). It would have been obvious to one of ordinary skill in the art at the time of the invention for Nielsen to have implemented the sequential category subcategory cascading interest term interface as shown in Smith, because Smith teaches that doing so allows a user's answers to be based on prior answers and can thus eliminate showing queries that are irrelevant based on the prior answers (Pages 12 & 14: Paragraphs 0176 & 0191). It was also notoriously well known in the art at the time of the invention to use expandable cascading selectable items as a way of maximizing the amount of relevant data displayed at one time on an interface (e.g.

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Windows File Manger with folders and subfolders only showing there contents when selected by a user).

-In regard to dependent claims 2, 9, and 16, Nielsen teaches providing a user dialog on said user display (column 4, lines 20-40), said user dialog comprising a sequential prompting for input (column 4, lines 29-37). Nielsen does not teach providing a series of questions in the form of interrogatory elements regarding available interest terms, and receiving an affirmative answer to at least one provided question. Smith teaches providing a series of questions (Page 12: Paragraph 0176: "a set of cascading screening questions") in the form of interrogatory elements (Page 12: Paragraph 0176: "asking whether they are "male" or "female"") regarding available interest terms (i.e. survey interest terms), and receiving an affirmative answer to at least one provided question (Page 12: Paragraph 0176). As taught in the above rejection of the independent claims, it would have been obvious to one of ordinary skill in the art at the time of the invention for Nielsen to have implemented the series of interrogatory elements regarding available interest terms as shown in Smith, because Smith teaches that doing so allows a user's answers to be based on prior answers and can thus eliminate showing queries that are irrelevant based on the prior answers (Pages 12 & 14: Paragraphs 0176 & 0191).

-In regard to dependent claims 3, 10, and 17, Nielsen teaches providing a user dialog on said user display (column 4, lines 20-40), said user dialog comprising a sequential prompting for input (column 4, lines 29-37). Nielsen does not teach providing

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an expandable master checklist of available interest terms, and receiving user selections of at least one available interest term on the master checklist. Smith teaches providing an expandable master checklist (Page 12: Paragraph 0176: "a set of cascading screening questions") of available interest terms (i.e. survey interest terms), and receiving user selections of at least one available interest term on the master checklist (Page 12:

Paragraph 0176). As taught in the above rejection of the independent claims, it would have been obvious to one of ordinary skill in the art at the time of the invention for Nielsen to have implemented the selectable expandable master checklist of available interest terms as shown in Smith, because Smith teaches that doing so allows a user's answers to be based on prior answers and can thus eliminate showing queries that are irrelevant based on the prior answers (Pages 12 & 14: Paragraphs 0176 & 0191).

-In regard to dependent claims 6, 13, and 20, Nielsen teaches storing a user interest term list in persistent memory of said web browser system (column 1, lines 61-62)(Fig. 3: 60 & 62).

11. Claims 4, 11, and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen et al (US-6,055,542 04/25/00) in view of Smith, JR. et al (US-2002/0128898 09/12/02) in further view of FOLDOC, "flat file," 01/26/96, <http://wombat.doc.ic.ac.uk/foldoc/foldoc.cgi?query=flat+file>.

-In regard to dependent claims 4, 11, and 18, Nielsen teaches storing a user interest term list in persistent memory of said web browser system (column 1, lines 61-62)(Fig. 3: 60 & 62) which could be a text file (column 1, line 62-63). Nielsen does not

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teach storing the user interest term list in a flat text file. It would have been obvious to one of ordinary skill in the art at the time of the invention, for Nielsen to have stored its text file as a flat text file, because FOLDOC teaches that flat files were well known in the art to be more portable between different operating systems and application programs. It was also generally well known in the art for flat files to be transferred and worked on very fast because they contained only data with no structural data being stored and thus required no transfer of unnecessary format data.

12. Claims 5, 12, and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen et al (US-6,055,542 04/25/00) in view of Smith, JR. et al (US-2002/0128898 09/12/02) in further view of Microsoft Computer Dictionary, Second Edition, 1994, pp. 105.

-In regard to dependent claims 5, 12, and 19, Nielsen teaches storing a user interest term list in persistent memory of said web browser system (column 1, lines 61-62)(Fig. 3: 60 & 62). Nielsen does not teach storing the user interest term list as a record in a database. It would have been obvious to one of ordinary skill in the art at the time of the invention for Nielsen to have stored the created user record in a database, because the Microsoft Computer Dictionary teaches it was notoriously well known at the time of the invention for data to be stored in records in a database which provides the benefit of searching, sorting, and recombining the data (pp. 105: database).



***Response to Arguments***

13. Applicant's arguments with respect to claim 09/01/04 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US-2002/0116470

08-2002

Dyer et al.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L Basehoar whose telephone number is (571)-272-4121. The examiner can normally be reached on M-F: 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (703) 308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB

  
JOSEPH FEILD  
SUPERVISOR, PATENT EXAMINER